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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,540	02/09/2000	Michael D. Hitchcock	P-01800-US1	3996

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 07/16/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/501,540

Applicant(s)

HITCHCOCK ET AL.

Examiner

Gregory J Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/09/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to application filing: Application filed on 2/9/2000.
2. Customer Change of Address/Power of Attorney filed on 9/18/2000 (paper #2)
3. IDS filed on 2/14/2001 (paper #3).
4. Claims 1-24 are pending in the case. Claims 1, 12 and 17 are independent claims.

Specification

5. The disclosure is objected to because it contains an embedded hyperlink and /or other forms of browser-executable code on page 7, line 8. Applicant is suggested to add left and right brackets or quotation marks on each side of the hyperlink to deactivate the hyperlink, or applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. US Patent Number 5,490,217 (patented 2/6/96).

In regard to independent claim 17,

Wang discloses a method of exchanging "documents and other forms of information" (column 1, lines 9 – 10) whereby Wang establishes an equality between the terms "document" and "information". Wang discloses receiving information (described as "document") in electronic form over a network (column 3, lines 6-9). Wang discloses transmitting a request (described as "document") in printed form to a second source (described as "third party") (column 6, lines 59-61). Wang discloses receiving information in facsimile format (described as FAX) (see figures 1 and 2), where the information includes automatically interpretable identifying information (described as "machine readable image code") (column 2, lines 30-31). Wang discloses automatically interpreting the identifying information (described as "machine readable image code") to associate (described as "processing instructions") the information (described as "document") (column 2, lines 30-32). Wang further defines "processing instructions" as "relating documents to an identified entity" (column 2, line 7).

In regard to dependent claim 19,

Wang discloses the identifying information as a bar code (column 1, line 58).

In regard to dependent claim 20,

Wang discloses the identifying information as alphanumeric characters (column 1 lines 50-52).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2178

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Independent claims 1 and 12 and dependent claims 6, 7, 8, 9, 10, 13, 15, 16, 22 and 24 are rejected under 35 USC 103(a) as being unpatentable over Wang et al. US Patent Number 5,490,217 (patented 2/6/96) in view Tammaro US Patent Number US2001/0011246A1 (filed 8/10/98, published 8/2/2001) and in further view of Webster's II New College Dictionary (published in 1995).

In regard to independent claim 1,

Wang discloses a method of transmitting and receiving a document (column 3 lines 1-7), over a network (column 4, line 1). Wang discloses "document", but fails to disclose "applications for admissions to institutions". However, Tammaro discloses a system transmitting an application to an institution (paragraph 26). Tammaro teaches that institution applications can be transmitted by a system.

Although, Wang discloses "transmitting" and "receiving", Wang fails to identify who the application is transmitted to and received from. However, Webster's definition of an "applicant" reads (page 55) "*One who applies, as for a job or admission.*". Webster's teaches that the intended user of an application is an "applicant".

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system and the teachings of Tammaro and Webster's at the time the invention was made to modify Wang's automatic document

handling method to provide a method for the transmission and reception of electronic applications for institution.

Also, in regard to independent claim 1,

Wang anticipates "automatically transmitting to a third party via facsimile a request for a document to be associated with the application." Wang discloses a facsimile transmitting device (described as "FAX") receiving instruction from a server (described as a "HOST COMPUTER") and transmitting to a second FAX device (see figure 1). Wang also discloses "a system for relating documents to an identified entity" (column 2, line 7), "instructions as to how the document is to be handled by the system" (column 3 lines 10-12) and transmitting through FAX to a third party (column 6, lines 59-61).

Wang also anticipates "receiving from the third party as facsimile data the document along with machine readable identifying information indicating the application to which the document is to be associated". Wang discloses "document with the resulting machine readable image code embedded will be transmitted through the same communication means back" (column 6, line 67 to column 7, lines 1-3) (compare receiving to transmitting back); where Wang's machine readable image code is used as in "a system for relating documents to an identified entity" (column 2, line 7).

Wang further anticipates "automatically determining from the facsimile data the identifying information and associating the facsimile data with the application, whereby the third party uses only a facsimile transmission device to transmit the document in electronic form and the machine readable identifying information facilitates automatic

matching of the document with the application at the institution." Wang discloses an automatic interpreter (described as a "decoder") (column 4, line 3) that associates a new document to an existing document (described as "machine readable image code which image code encodes identifying content") (Column 2, line 30) "for relating documents to an identified entity" (column 2, line 7) by "fax communications" (see figures 1 and 2).

10. In regard to independent claim 12,

Wang discloses an apparatus with a server, facsimile device and an encoder and decoder (embodied as a standard micro-computer) that interpret identifying information (see column 3, lines 65-67, and column 4 lines 1-4). Wang discloses the apparatus functioning as a server (described as "the system") transmitting and receiving a document (column 2, line 61 through column 3, line 7), a server instructing a facsimile device to transmit a document (see figures 1 and 2), identifying information that instructs the server to associate the document to an existing entity (column 2, line 7 and column 3, lines 10-12). Wang discloses "document", but fails to disclose "form". However Tammaro discloses "form" (see figure 2). Tammaro teaches that a "form" can be transmitted and received.

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system and the teachings of Tammaro at the time the invention was made to modify Wang's automatic document handling system to

provide transmission, reception, encoding and decoding of forms for applicants, thereby providing a method of automatic document handling of forms.

11. In regard to dependent claim 6,

Wang discloses a method for storing a file in facsimile format (described as "FAX") (see figure 3) and associating the file to an applicant (described as "relating documents to an identified entity) (column 2, line7).

12. In regard to dependent claim 7,

Tammaro discloses verifying that the third party (described as "finance source") is participating in the transmission program (see figure 2, reference 112 and 116), and transmission by facsimile (page 1, paragraph 7).

13. In regard to dependent claim 8,

Tammaro discloses verifying if the institution (described as "finance source") is participating in the transmission program (see figure 2, references 112 and 116).

14. In regard to dependent claims 22,

Tammaro discloses a system that manages first information (described as "credit application") (page 1 paragraph 6) and second information (described as "department of motor vehicles forms") (page 1, paragraph 7), where the information is received and transmitted by a service provider (described as "credit application service provider")

(page 1, paragraph 7), and transmitting the information to an end user (described as "user") (see figure 2).

15. In regard to dependent claims 24,

Tammaro discloses determining if the second source (described as "department of motor vehicles") agrees to transmit via facsimile the second information (described as "department of motor vehicles forms") (page 1, paragraph 7).

16. In regard to dependent claims 9, 10 and 13,

Wang discloses a method of transmitting documents (column 3, lines 2-3) and "all kinds of business transaction forms" (column 6, line 26).

17. In regard to dependent claims 15 and 16,

Wang discloses an apparatus, which includes an interpreter (column 3, line 65-66) line that has the ability to encode/decode machine-readable image code (column 4, line 10-12) where the machine readable image code can be either bar codes or alphanumeric characters (column 1, lines 50-58).

18. Dependent claims 2, 3, 4, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's and further in view of Schmid et al., U.S. Patent 5,659,164 (patented on 8/19/97).

In regard to dependent claims 2, 18 and 23,

Wang and Tammaro fail to disclose the use of a cover sheet to contain the identifying information for the related document. Schmidt discloses the use of cover sheet in column 3, line 37 as follows: "a cover sheet bearing machine-readable code markings containing identification of the document owner and desired routing ..."

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system, Tammaro's auto credit application and the teaching of Schmid, at the time the invention was made, to add Schmid's facsimile cover sheet containing the identifying information to Wang's automatic document handling system to achieve a system that can associate the document to an existing record in the system.

In regard to dependent claims 3 and 4,

Wang discloses the identifying information in the form of a bar code or of alphanumeric characters (column 1, lines 50-59).

19. Claims 5 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's, further in view of Mowry et al., U.S. Patent 5,853,197 (patented 12/29/98).

In regard to dependent claims 5 and 21,

Wang discloses "document" but fails to disclose "transcripts". However, Mowry discloses "college transcript" at column 1 line 14.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add "transcripts" to the inventions of Wang and Tammaro to provide a method for requesting and receiving transcripts by facsimile.

20. Dependent claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's, further in view of MacPhail, U.S. Patent 5,089,956 (patented 2/18/92).

In regard to dependent claims 11 and 14,

Wang and Tammaro fail to disclose transmission timing in the Automatic Document Handling System invention, but MacPhail discloses an "after" event timing of document transmission in column 3, line 49. MacPhail discloses the following: "After the dialog manager application has gathered the above-identified information, it transmits the information ..."

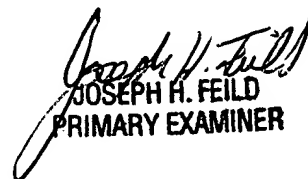
Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system, Tammaro's auto credit application system and the teaching of MacPhail, at the time the invention was made, to incorporate event timing of transmission of documents into the automated document handling system to achieve a system that can manage associated documents where the documents are to be processed at different times.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


JOSEPH H. FEILD
PRIMARY EXAMINER

GJV
July 11, 2003